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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92032341
Party	Defendant MICHEL FARAH
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Submission	Motion to Suspend for Civil Action
Filer's Name	David M. Rogero
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Signature	/s/David M. Rogero/
Date	03/13/2006
Attachments	Motion to suspend 031306.pdf (2 pages) Gapardis v Pramil Complaint 031306.tif (14 pages)

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PRAMIL S.R.L. (ESAPHARMA),)	Cancellation No. 92032341
)	Registration No. 2,447,970
Petitioner,)	Mark: OMIC PLUS
)	
v.)	
)	
MICHEL FARAH,)	
)	
Registrant.)	
_____)	

REGISTRANT'S MOTION TO SUSPEND PROCEEDING

Registrant, Michel Farah respectfully moves pursuant to 37 C.F.R. §2.117 for suspension of this proceeding. A civil action that involves the mark that is the subject of this proceeding, as well as other marks, has been filed in the United States District Court for the Southern District of Florida by the licensee of the Registrant against the Petitioner. The litigation will have a bearing upon this proceeding. A copy of the complaint, filed March 13, 2006, is attached.

Respectfully submitted,

/s/David M. Rogero/
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Attorney for Registrant Michel Farah

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Motion to Suspend Proceeding was sent by first class mail with proper postage affixed, the 13th day of March, 2006, to the following counsel for petitioner:

Donald L. Dennison
Dennison, Schultz, Dougherty
1727 King Street, Suite 105
Alexandria, VA 22314

/s/David M. Rogero/

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

Case No. _____

GAPARDIS HEALTH AND BEAUTY,)
INC.,)

Plaintiff,)

v.)

PRAMIL S.R.L. (ESAPHARMA) and)
INTERNATIONAL BEAUTY)
EXCHANGE, INC.)

Defendants.)
_____)

06-20619
CIV-MORENO

MAINTENANCE JUDGE ?

WASHINGTON

2006 MAR 13 AM 10:33

COMPLAINT

Plaintiff, Gapardis Health & Beauty, Inc. (herein "the Mitchell Group"), by its undersigned attorney, for its Complaint against the Defendants, alleges as follows:

I. The Nature of the Action

1. This is an action for injunctive and monetary relief for trademark infringement in violation of Sections 32 and 43 of the Lanham Trademark Act (15 U.S.C. § 1114 and 1125), for counterfeiting in violation of the Trademark Counterfeiting Act of 1984 (15 U.S.C. § 1116-17), for false descriptions and representations in commerce under Section 43 of the Lanham Trademark Act (15 U.S.C. § 1125), for cancellation of the registration of a mark pursuant to § 37 of the Lanham Trademark Act (15 U.S.C. § 1119), and for unfair competition and unjust enrichment in violation of Florida common law.

II. The Parties

2. Plaintiff the Mitchell Group was, at all times pertinent, and is, a corporation organized under the laws of Florida with its principal place of business in Miami, Florida, which does business as The Mitchell Group.

3. Upon information and belief, defendant Pramil S.R.L. (Esapharma) (herein "Pramil") was, at all times pertinent, and is, a corporation organized under the laws of Italy, which regularly conducts business within the United States and in the state of Florida.

4. Upon information and belief, defendant International Beauty Exchange, Inc. (herein "IBE") was, at all times pertinent, and is, a corporation organized under the laws of the State of Florida, with its principal place of business at 1592 N.W. 159th Street, Miami, Florida 33169. Upon information and belief, IBE is a wholesaler and distributor of health and beauty products.

III. Jurisdiction and Venue

5. This Court has jurisdiction over the subject matter of this action, pursuant to 28 U.S.C. § 1331, 1338 and 1367.

6. The defendants are subject to personal jurisdiction in that they reside, transact or do business in Florida and the infringing and counterfeit products which are the subject of this action are being distributed in Florida.

7. Venue is proper in this judicial district, pursuant to 28 U.S.C. 1391(b)(1) and (2), because one of the defendants resides in the district, a substantial part of the events giving rise to the claims occurred in this district, and a substantial part of the property that is the subject matter of the action is situated within this district.

IV. Plaintiff's Marks

8. The Mitchell Group conducts business in commerce as a distributor of beauty and skin care products, including the importation and wholesale and retail sales of such products. Among other products, the Mitchell Group distributes and sells soaps, lotions, milks, creams, and gels for the face and body bearing the trademarks CAROTIS, OMIC PLUS, PRECIOUS, IKB, REGGE LEMON and LEXUS OF ENGLAND.

9. The Mitchell Group is the owner of the trademark CAROTIS, which is registered with the United States Patent and Trademark Office, under Registration No. 2580543. The mark was registered on January 28, 2003, based upon first use in commerce in 1998.

10. The Mitchell Group is the exclusive licensee for the sale and distribution of products bearing the trademark OMIC PLUS in the United States. The mark OMIC PLUS is owned by Michel Farah, and is registered with the United States Patent and Trademark Office under Registration No. 2447970. The mark was registered on May 1, 2001, based upon first use in commerce in November 1990.

11. The Mitchell Group is the exclusive licensee for the sale and distribution of products bearing the trademark PRECIOUS in the United States. The mark PRECIOUS is owned by Precious Beauty Products, Ltd., and is registered with the United States Patent and Trademark Office under Registration No. 2603832. The mark was registered on August 6, 2002, based upon first use in commerce in 1996.

12. The Mitchell Group is the exclusive licensee for the sale and distribution of products bearing the trademark IKB in the United States. The mark is owned by IKB Industries Nigeria Limited, of Lagos, Nigeria, which has filed an application for the

registration with the United States Patent and Trademark Office under Serial No. 76580836, based upon first use in commerce in February 1988.

13. The Mitchell Group is the exclusive licensee for the sale and distribution of products bearing the trademark REGGE LEMON in the United States. The mark is owned by Duwin Pharmaceutical and Chemical Co. Ltd., of Lagos, Nigeria. The Mitchell Group has been using this mark in commerce since at least January of 1992.

14. The Mitchell Group is the exclusive licensee for the sale and distribution of products bearing the trademark LEXUS OF ENGLAND (and design), which is registered with the State of Florida on February 14, 2000, by the owner of the mark, Mitchell Cosmetics, Inc., Kingstown, St. Vincent and the Grenadines.

15. The packaging and trade dress of the products marketed by the Mitchell Group under each of the marks CAROTIS, OMIC PLUS, PRECIOUS, IKB, REGGE LEMON and LEXUS OF ENGLAND is distinctive.

16. The health and beauty products distributed by the Mitchell Group under the marks CAROTIS, OMIC PLUS, PRECIOUS, IKB, REGGE LEMON and LEXUS OF ENGLAND are marketed to an ethnic market which includes the African and Caribbean markets. The Mitchell Group has devoted efforts to the marketing and promotion of CAROTIS, OMIC PLUS, PRECIOUS, IKB, REGGE LEMON and LEXUS OF ENGLAND health and beauty products in such ethnic markets.

17. Products bearing the CAROTIS, OMIC PLUS, PRECIOUS, IKB, REGGE LEMON and LEXUS OF ENGLAND trademarks and the trade dress of such products have come to be known by the African and Caribbean markets throughout the U.S. as health and beauty aids of the highest quality. Therefore, the CAROTIS, OMIC PLUS,

PRECIOUS, IKB, REGGE LEMON and LEXUS OF ENGLAND trademarks and their trade dress and the good will associated with them are of inestimable value to Plaintiff.

18. Net sales of CAROTIS, OMIC PLUS, PRECIOUS, IKB, REGGE LEMON and LEXUS OF ENGLAND products in the U.S. by the Mitchell Group have been substantial. As the unit cost for these products is small, these sales represent a considerable quantity of product.

19. In settlement of prior litigation, defendant IBE entered into a Global Settlement Agreement, as of September 8, 2003, with a number of other parties, including the Mitchell Group, and upon information and belief with the knowledge and consent of Pramil, in which it was agreed, among other things, that:

A. IBE waived and relinquished all right, title and interest in and to the mark CAROTIS and associated trade dress and transferred and assigned all such right, title and interest to the Mitchell Group, and IBE agreed that it would “immediately and permanently cease and desist from manufacturing, exporting, importing, distributing selling, offering for sale or engaging in any other commercial activities with respect to products bearing the CAROTIS Trademarks, both counterfeit and genuine.”

B. IBE waived and relinquished all right, title and interest in and to the mark PRECIOUS and associated trade dress and transferred and assigned all such right, title and interest to the Mitchell Group, and IBE agreed that it would “immediately and permanently cease and desist from manufacturing, exporting, importing, distributing selling, offering for sale or engaging in any other commercial activities with respect to products bearing the PRECIOUS Trademarks, both counterfeit and genuine.”

V. The Defendants' Scheme

20. Upon information and belief, the defendants have devised a scheme to distribute products bearing reproductions, counterfeits, copies and colorable imitations of one or more of the CAROTIS, OMIC PLUS, PRECIOUS, IKB, REGGE LEMON and LEXUS OF ENGLAND trademarks and the trade dress of products bearing those marks.

21. Pursuant to this scheme, defendants have distributed the same types of products as those distributed by the Mitchell Group, under brands and trade dress that copy or imitate the marks and trade dress used by the Mitchell Group, namely CAROTIS, OMIC PLUS, PRECIOUS, IKB, REGGE LEMON and LEXUS OF ENGLAND.

22. In furtherance of the defendants' scheme, the defendants caused to be filed with the U.S. Patent and Trademark Office, in the name of Pramila, an opposition proceeding, opposing the application of Mitchell Cosmetics SARL, a Swiss corporation, to register the trademark REGGE LEMON. Because of the failure of Mitchell Cosmetics SARL to submit evidence in support of its application, and not based upon a determination on the merits, defendants' opposition proceeding was successful, and the application of Mitchell Cosmetics SARL was deemed abandoned on February 16, 2006.

23. In furtherance of the defendants' scheme, the defendants caused to be filed with the U.S. Patent and Trademark Office, in the name of IBE, an application for registration of the mark REGGE LEMON, based upon a claimed first use of such mark on April 20, 1997, on cosmetics in International Class 003 and on medicated skin care preparations in International Class 005.

24. In furtherance of the defendants' scheme, the defendants caused to be filed with the U.S. Patent and Trademark Office, in the name of Pramila, a cancellation

proceeding, seeking the cancellation of the registration by Michel Farah if the trademark OMIC PLUS. Defendants' cancellation proceeding remains pending before the U.S. Trademark Trial and Appeals Board.

25. In furtherance of the defendants' scheme, defendant IBE caused to be filed with the U.S. Patent and Trademark Office, on February 16, 2006, an application for registration of the mark OMIC, based upon a claimed first use of such mark on May 13, 1994, on cosmetics in International Class 003.

26. In furtherance of the defendants' scheme, defendant IBE caused to be filed with the U.S. Patent and Trademark Office, on February 21, 2006, an application for registration of the mark OMIC PLUS, based upon a claimed first use of such mark on May 13, 1994, on cosmetics in International Class 003.

27. In furtherance of the defendants' scheme, defendant IBE caused to be filed with the U.S. Patent and Trademark Office an application for registration of the mark PRECIOUS BEAUTY, based upon a claimed first use of such mark in May 2003 on body and hair care products in International Class 003. This mark was registered on May 10, 2005, under Registration No. 2948923. In late 2005 or early 2006, defendants began distributing products bearing the PRECIOUS BEAUTY mark which imitate the trade dress of products distributed by the Mitchell Group under the PRECIOUS mark.

28. In furtherance of the defendants' scheme, upon information and belief, Defendants designed, purchased, distributed and sold their infringing products, as alleged below, knowing them to be infringing, and in some instances counterfeit, or at a minimum, purchased and sold their products with willful blindness as to their authenticity.

29. The sale and distribution of the infringing products by defendants has and will cause substantial and irreparable damage to Plaintiff in at least the following respects:

(i) The infringement by defendants of registered trademarks and trade dress will mislead and confuse consumers as to the origin and source of the products;

(ii). The distribution and sale by defendants of the infringing products will cause irreparable damage to the invaluable reputation and goodwill that Plaintiff has built for its trademarks and trade dress;

(iii) When the consumer purchases the infringing products, the consumer will be misled into believing that he is purchasing plaintiff's products. However, the infringing products potentially exposes consumers to, among other things, the hazards of contaminated ingredients, defective manufacture or negligent handling; and

(iv) The infringement by defendants of plaintiff's trademarks and trade dress will dilute the distinctive quality of the trademarks and trade dress.

COUNT I

30. Plaintiff repeats and realleges paragraphs 1 through 29 as if fully set forth herein.

31. In violation of 15 U.S.C. § 1114(1)(a), defendants used in commerce, without plaintiff's consent, either a reproduction, counterfeit, copy or colorable imitation of the registered trademarks CAROTIS, OMIC PLUS, and PRECIOUS in connection with the sale, offering for sale, distribution, or advertising of defendants' infringing products which use is likely to cause confusion, or to cause mistake or to deceive.

32. Plaintiff has been and continues to be damaged by the defendants above-stated activities and conduct. Defendants have profited thereby and, unless defendants are enjoined, Plaintiff's business, goodwill and reputation will suffer irreparable injury which cannot be adequately calculated or compensated for solely by money damages.

COUNT II

33. Plaintiff repeats and realleges paragraphs 1 through 29 as if fully set forth herein.

34. In violation of 15 U.S.C. § 1114(1)(b), defendants reproduced, counterfeited, copied or colorably imitated the registered trademarks CAROTIS, OMIC PLUS, and PRECIOUS and applied such reproductions, counterfeits, copies or colorable imitations to labels and packages intended to be used in commerce upon or in connection with the offering for sale, distribution or advertising of defendants' infringing products which use is likely to cause confusion, to cause mistake or to deceive.

35. Plaintiff has been and continues to be damaged by the defendants' above-stated activities and conduct. The defendants have profited thereby and, unless defendants are enjoined, plaintiff's business, goodwill and reputation will suffer irreparable injury which cannot be adequately calculated or compensated for solely by money damages.

COUNT III

36. Plaintiff repeats and realleges paragraphs 1 through 29 as if fully set forth herein.

37. In violation of 15 U.S.C. §1125(a)(1)(A), defendants, in connection with the distribution and sale of products that infringe upon the trademarks CAROTIS, OMIC

PLUS, PRECIOUS, IKB, REGGE LEMON and LEXUS OF ENGLAND, and upon the trade dress of products marketed by the Mitchell Group under such marks, used in commerce words, terms, names, symbols, or devices, or combinations thereof, or false designations of origin, false or misleading descriptions of fact or false or misleading representations of fact, which were likely to cause confusion or to cause mistake, or to deceive as to the approval of the defendants' goods by plaintiff.

38. Plaintiff has been and continues to be damaged by the defendants' above-stated activities and conduct. The defendants have profited thereby and, unless the defendants are enjoined, plaintiff's business, goodwill and reputation will suffer irreparable injury which cannot be adequately calculated or compensated for solely by money damages.

COUNT IV

39. Plaintiff repeats and realleges paragraphs 1 through 29 as if fully set forth herein.

40. In violation of 15 U.S.C. § 1125(a)(1)(B), defendants, in connection with the distribution and sale of products that infringe upon the trademarks CAROTIS, OMIC PLUS, PRECIOUS, IKB, REGGE LEMON and LEXUS OF ENGLAND, and upon the trade dress of products marketed by the Mitchell Group under such marks, used words, terms, names, symbols, or devices or combinations thereof, or false designations of origin, false or misleading descriptions of fact or false or misleading representations of fact, which in commercial advertising or promotion, misrepresented the nature, characteristics, qualities or geographic origin of the defendants' infringing products..

41. Plaintiff has been and continues to be damaged by the defendants' above-stated activities and conduct. The defendants have profited thereby and, unless defendants are enjoined, plaintiff's business, goodwill and reputation will suffer irreparable injury which cannot be adequately calculated or compensated for solely by money damages.

COUNT V

42. Plaintiff repeat and reallege paragraphs 1 through 29 as if fully set forth herein.

43. In violation of the common law of the State of Florida, defendants have unfairly competed with plaintiff by packaging, labeling and/or selling the defendants' infringing products.

44. Plaintiff has been and continues to be damaged by the defendants' above-stated activities and conduct. The defendants have profited thereby and, as a result, plaintiff is entitled to punitive damages from the defendants.

COUNT VI

45. Plaintiff repeats and realleges paragraphs 1 through 29 as if fully set forth herein.

46. Based on defendants' counterfeiting of plaintiff's genuine products, defendants have unjustly enriched themselves at Plaintiff's expense.

47. Equity and good conscience dictate that defendants not be permitted to retain the profits from their counterfeiting of plaintiff genuine products.

48. Plaintiff has been damaged by a sum which cannot be ascertained at this time.

49. Plaintiff has no adequate remedy at law.

COUNT VII

50. Plaintiff repeats and realleges paragraphs 1 through 8, 11, 14 through 21, and 27 through 29, as if fully set forth herein.

51. Plaintiff believes that it is or will be damaged by Defendant's registration of the mark PRECIOUS BEAUTY on the principal register.

RELIEF SOUGHT

WHEREFORE, Plaintiff demands judgment against the Defendants as follows:

(a) that preliminary and permanent injunctions be issued enjoining Defendants, their subsidiaries, parents, affiliates, agents, servants, employees, directors, officers and attorneys and those persons or entities in active concert or participation with them:

(i) From using infringing and counterfeit products bearing Plaintiff's trademarks or reproductions, counterfeits, copies or colorable imitations thereof;

(ii) Except for surrendering to Plaintiff the infringing and counterfeit products, from possessing, receiving, manufacturing, assembling, distributing, warehousing, shipping, transshipping, transferring, storing, advertising, promoting, offering, selling, offering or holding for sale, disposing, or in any other manner handling or dealing with any goods, packaging, wrappers, containers and recepticals, and any catalogues, price lists, promotional materials and the like bearing a copy or colorable imitation of the plaintiff's trademarks and/or trade dress;

(iii) From infringing the plaintiff's trademarks and/or trade dress;

(iv) From otherwise unfairly competing with Plaintiff

(v) From using any reproduction, counterfeit, copy or colorable imitation of the plaintiff's trademarks and/or trade dress in connection with publicity, promotion, sale or advertising of goods sold by defendants, including, without limitation, health and beauty products bearing a copy or colorable imitation of the plaintiff's trademarks and/or trade dress;

(vi) From affixing, applying, annexing or using in connection with the same any goods, false description or any representation, including words or other symbols, falsely describing, falsely representing such goods as being those of Plaintiff and from offering such goods in commerce;

(vii) From using any trademark, trade name or trade dress in connection with the manufacture, sale or distribution of any goods which may be calculated to falsely represent such goods as being connected with, approved by or sponsored by plaintiff;

(viii) From destroying, altering, disposing of, moving, removing, concealing, tampering with or in any manner secreting any and all business records, invoices, correspondence, books of account, receipts or any other documents or things relating or referring in any manner to the manufacture, advertising, receiving, acquisition, importation, purchase, sale or offer for sale, distribution, warehousing or transfer of any Counterfeit Products bearing the plaintiff's trademarks and/or trade dress;

(ix) From assisting, aiding or betting any other person or business entity in engaging in or performing any of the activities referred to in subparagraphs (i) through (viii) above;

(b) that all infringing material be ordered seized, impounded and destroyed;

(c) that Plaintiff be awarded from the Defendants their damages in an amount to be ascertained at trial, trebled, and reasonable costs, investigative expenses and attorneys' fees, pursuant to 15 U.S.C. §1117, or an award of statutory damages, pursuant to 15 U.S.C. §1117(c); including reasonable costs, investigative expenses and attorneys' fees.

(d) that Plaintiff be awarded from the Defendants punitive damages in an amount to be ascertained at trial;

(e) that Plaintiff be awarded from the Defendants an amount to be ascertained at trial, for unfair competition and/or unjust enrichment;

(f) that Defendant's registration of the mark PRECIOUS BEAUTY be cancelled, pursuant to 15 U.S.C. §§ 1064 and 1119.

(f) that Plaintiff be awarded such other and further relief as may be just and proper under the circumstances.

Dated: March 10, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David M. Rogero", is written over a horizontal line.

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